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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/065,516 | 10/25/2002 | Rodolfo Paillaman | 24-NS-123144 | 2138 |

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| EXAMINER | |
|---|---|
| PALABRICA, RICARDO J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3641 | |

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/065,516 | PAILLAMAN ET AL. | |
| | Examiner | Art Unit | |
| | Rick Palabrica | 3641 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 02 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

MICHAEL J. C[illegible]
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive; they are: a) based on misrepresentations of Examiner's rejections; and b) not supported by either the original specification or the previous admissions made by the Applicant himself.

Applicant traversed the final rejection of claims in Office Action dated 10/2/03 on grounds that the De Briere et al.- Johnson combination applied by the Examiner does not render the claimed invention obvious. The Examiner disagrees because this argument is based on a "strawman" constructed by the Applicant, which is totally different from the prior art applied by the Examiner. As discussed in Section 4 of said Office Action, the 35 U.S.C. 103(a) rejection was based not only on the De Briere et al. - Johnson combination but also on Applicant's own admission of prior art on pages 9 and 10 of the Remarks section of his 9/9/03 Amendment. Applicant admits therein that "one skilled in the art would know how to position an ultrasonic phased array probe adjacent the bottom surface of the jet pump beam." When this admission is combined with the teaching of Johnson to appropriately modify the method of De Briere et al., Applicant's claimed invention would be obvious. In fact, the claimed bottom surface positioning of the ultrasonic probe is so notorious in the art that Applicant himself was able to identify a plurality of distinct, alternative methods of probe positioning. He states, "any suitable means of positioning the ultrasonic phased array probe would satisfy the recitations of the claims, for example, an ultrasonic positioning tool, a robotic tool manipulator, or manual positioning by hand." See page 9, last pararaph of Remarks in said Amendment.

Applicant further alleges that "just because one skilled in the art would know how to position an ultrasonic phased array probe adjacent the bottom surface of a jet pump beam after he has read the Applicant's application does not make positioning an ultrasonic phased array probe adjacent the bottom surface of a jet pump beam obvious." Again, this is an argument based on an Applicant-constructed "strawman" that is neither supported by the original specification nor the 9/9/03 Amendment. Applicant's own admission regarding the well-known art of probe positioning does not state that an artisan would need to "read the Applicant's application" in order to be able to postion a probe (see page 9, lines 16-18 of said Amendment).

Based on the above, Applicant's arguments in his 1/2/03 Amendment After Final have no firm basis. The Examiner also notes that there no claim amendments were submitted as part of the 1/2/03 letter requesting reconsideration.